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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,553	01/12/2004	Patrice Aguilera	43315-201407	9284
26694	7590	09/21/2005	EXAMINER	
VENABLE LLP			NEWVILLE, TONI E	
P.O. BOX 34385			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20045-9998			3671	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/754,553

Applicant(s)

AGUILERA, PATRICE

Examiner

Toni Newville

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 6 and 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1-12-2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

2. Claims 6 and 12 are objected to because of the following informalities: The particular device that the word "it" refers to in line 2 of both claims must be explicitly

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stated. It appears that "it" in claim 6 refers to the at least one guide member, and in claim 12, "it" refers to the subsea oil and/or gas exploitation device. The claim will be examined with the assumption that this was the intended meaning. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte*

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Hasche, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation "a low-friction material", and the claim also recites "preferably a polymer, most preferably poly-tetra-fluor-ethylene" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Pokladnik et. al., US 4438817.

Regarding claim 1, Pokladnik discloses:

A subsea oil and/or gas exploitation device (12), comprising a guide member (piping structure of Fig. 1) for guiding subsea equipment that is to be landed and connected to said device (12) into a connecting position in relation to said device (12), wherein said at least one guide member comprises an array of projections (36, 37, 38, 39) provided for the purpose of engaging corresponding recesses (bottom of 81, 82, 83, 84) arranged in a corresponding guide member (top of Fig. 3) of the subsea equipment (column 5 lines 50-53).

Regarding claim 2, each projection (36, 37, 38, 39) has a tapered end portion (Fig. 1).

Regarding claim 3, the projections project in a generally vertical direction when in an operative position (Fig. 1).

Regarding claim 15, the projections (36, 37, 38, 39) are arranged circumferentially around a center axis of the guide member (Fig. 1).

Regarding claim 16, the projections (36, 37, 38, 39) are evenly angularly distributed around a center axis of the guide member (Fig. 1).

Regarding claim 17, the device (12) is a base device that is to be located on the sea bottom (column 3 lines 4-5).

Regarding claim 18, the device (12) defines a well template and wherein the equipment to be seated thereon comprises a Christmas tree (22).

7. Claims 5-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Zaremba, US 4174011.

Regarding claim 5, Zaremba discloses a subsea oil and/or gas exploitation device (16), comprising:

A guide member (40) for guiding subsea equipment (22) that is to be landed and connected to said device into a connecting position in relation to said device (16), wherein said at least one guide member (40) comprises an array of recesses (93) provided for the purpose of engaging corresponding projections (90) arranged at a corresponding guide member (80) of the subsea equipment (22) to be connected thereto (column 5 lines 5-8).

Regarding claim 6, the guide member (40) comprises a hollow body, the inner periphery of which defines a truncated cone, said recesses (93) being provided in the wall of said body (Fig. 5).

Regarding claim 7, the hollow body defines a funnel, the recesses (93) being provided in the wall of the funnel (Fig. 5).

Regarding claim 8, the projections or recesses (93) are arranged circumferentially around a center axis of the guide member (Fig. 1).

Regarding claim 9, the projections or recesses (93) of an individual guide member (40) are evenly angularly distributed around a center axis of the guide member (Fig. 5).

Regarding claim 10, the device (16) is a base device that is to be located on the sea bottom (Fig. 1).

Regarding claim 11, the device (16) defines a well template (Fig. 1) and the equipment to be seated thereon comprises a blow out preventer (column 1 lines 56-57).

Regarding claim 12, the device (16) comprises a plurality of guide members (reference number 40 in Fig. 2), one for each well or drill hole.

8. Claims 5, 7, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham et. al., US 5992526.

Regarding claim 5, Cunningham discloses a subsea oil and/or gas exploitation device (Fig. 1) comprising:

A guide member (20) for guiding subsea equipment (30) that is to be landed and connected to said device (Fig. 1) into a connecting position in relation to said device (Fig. 1), wherein said at least one guide member (20) comprises an array of recesses (26) provided for the purpose of engaging corresponding projections (32) arranged at a

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corresponding guide member (bottom of 30) of the subsea equipment (30) to be connected thereto (column 5 lines 5-8).

Regarding claim 7, Cunningham discloses the device comprising a hollow body (Fig. 1), the inner periphery of which defining a truncated cone (24), and the hollow body defining a funnel (24), the recesses (26) provided in the wall of the funnel (24).

Regarding claim 13, the device defines a Christmas tree (10).

9. Claim 1 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hopper, US 5085277.

Regarding claim 1, Hopper discloses a subsea oil and/or gas exploitation device (17), comprising: at least one guide member (surrounding 17) for guiding subsea equipment (25) that is to be landed and connected to said device (17) into a connecting position in relation to said device, wherein said at least one guide member comprises an array of projections (27), provided for the purpose of engaging corresponding recesses (bottom of 28) arranged in a corresponding guide member (28) of the subsea equipment (25).

Regarding claim 19, the device (17) defines a blow out preventer (column 4 lines 47-48).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pokladnik et. al., US 4438817, in view of Rytlewski et. al., US 6231265.

Pokladnik discloses a device as described above. Pokladnik fails to disclose each projection comprising an outer layer of a low-friction material, preferably a polymer, and most preferably poly-tetra-fluor-ethylene.

Like Pokladnik, Rytlewski discloses mating subsea devices, including a first component having a projection (112) for insertion into a recess (64) of a second component (column 4 lines 9-11). Unlike Pokladnik, Rytlewski discloses coating the surface of the projection (112) with poly-tetra-fluor-ethylene (column 4 lines 25-27).

Given the suggestion in Rytlewski, it would have been obvious to one of ordinary skill in the art to modify the device of Pokladnik as taught in Rytlewski to minimize friction between the two components so that maintenance and repair costs due to damage and wear are reduced.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham et. al., US 5992526, in view of Peterman et. al., US 6325159.

Cunningham discloses a subsea oil and/or gas exploitation device as described above, including a device defining a Christmas tree (10) comprising a guide member (20) provided for the purpose of engaging corresponding projections (32) arranged at a corresponding guide member (30) of the subsea equipment to be connected thereto (column 5 lines 5-8). Cunningham fails to disclose an alternative device, such as a pump or separator, as the subsea oil and/or gas exploitation device.

Like Cunningham, Peterman discloses a subsea oil and/or gas exploitation device (40), in this case comprising a guide member with a recess (112) for engaging a corresponding projection (115) arranged at a corresponding guide member (bottom of 42) of the subsea equipment to be connected thereto (42). Unlike Cunningham, Peterman discloses the device (40) defining a mud pump (102).

Given the suggestion in Peterman, it would have been obvious to one of ordinary skill in the art to include the mud pump subsea oil and/or gas exploitation device (40) of Peterman in addition to the arrangement of Cunningham, because pumps are commonly known pieces of subsea equipment that are removably connected with recesses to improve the efficiency of installation.

13. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hopper, US 5085277, in view of Pokladnik et. al., US 4438817.

Hopper discloses a subsea oil and/or gas exploitation device (17) as described above, including a blow out preventer (17) containing a guide member having

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projections (27) for engaging recesses in a corresponding guide member of a piece of subsea equipment (25). Hopper fails to disclose using an alternative piece of equipment to a blowout preventer for engaging a corresponding guide member of a piece of subsea equipment.

Like Hopper, Pokladnik discloses a subsea oil and/or gas exploitation device on which equipment is landed and connected. Unlike Hopper, Pokladnik includes a separator package (25) with upwardly extending projections (104, 105, 106, 107) analogous to those shown in the device of Hopper.

Given the teaching in Hopper, it would have been obvious to one of ordinary skill in the art to include the separator package (25) of Pokladnik in the device of Hopper because the separator package (25) has an analogous guide member and projection structure as the blowout preventer (Hopper; 17) in Hopper, and separators are common pieces of subsea equipment that are often placed above or below other types of wellhead equipment for more efficient subsea production.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toni Newville whose telephone number is (571) 272 - 1548. The examiner can normally be reached on Monday - Friday 8 am - 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on (571) 272-6998. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Toni Newville
September 12, 2005



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Group 3600